

REMARKS

This is a full and timely response to the outstanding final Office Action mailed May 18, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Objections

Claims 17-20 and 24 have been objected to for containing various informalities. In response to the objection, Applicant has amended the claims in the manner suggested by the Examiner.

In view of the above-noted claim amendments, Applicant respectfully submits that the claims are not objectionable and requests that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1-3, 6, 9-11, 14, 17-20, and 25-28

Claims 1-3, 6, 9-11, 14, 17-20, and 25-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford (GB Pat. No. 2331820). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the Crawford reference does not teach or suggest all of the claim limitations. Applicant discusses the Crawford reference and Applicant's claims in the following.

1. Independent Claims

In the final Office Action, the Examiner argues the following:

Regarding Claims 1, 9, 17, 25/26 and 27/28, Crawford discloses receiving a user's finger provided in a lid that covers an image window of a scanner of a multifunction peripheral (Page 1, lines 1-25, 36-38, Page 2, lines 1-11; Figure 1.

[Office Action, page 3, section 6]

As a first matter, Applicant notes that each of independent claims 1, 9, 17, 25, and 27 comprise different limitations, and cannot be considered as claiming the same invention. Therefore, the actual limitations of each claim must be independently considered when determining the patentability of those claims.

Second, Applicant asserts that the above statement by the Examiner is clearly untrue. As was described in Applicant's previous Response, Crawford discloses a machine, such as a photocopying or multi-function machine, that includes an independent fingerprint sensor provided in a user interface. Crawford, page 1, lines 33-35. More particularly, Crawford discloses a fingerprint sensor (e.g., sensor 40, Fig. 1) that is provided in a user interface 30 that comprises "a keyboard or keypad through which operation of the document platform 10 can be programmed." Crawford, page 2, lines- 2-5. The fingerprint sensor includes its own dedicated processing circuitry and clearly is separate from any scanning bed of the machine (see, e.g., Fig. 1).

Nothing in the Crawford disclosure (*including* page 1, lines 1-25, 36-38, page 2, lines 1-11, and Figure 1) mentions receiving a user's finger in an area that "covers an image window of a scanner". In fact, as is described above, Crawford teaches the opposite: Crawford's finger sensor is provided in a user interface separate from the rest of the machine, including any "image window of a scanner". Moreover, *nothing* in the Crawford disclosure (*including* page 1, lines 1-25, 36-38, page 2, lines 1-11, and Figure 1) mentions anything about a "lid".

Turning to the actual, explicit limitations of Applicant's claims, Crawford does not teach or suggest a method comprising receiving a user's finger "within a *finger slot provided in a lid that covers an image window of a scanner of a multifunction peripheral*" as is provided in claim 1. First, Crawford does not disclose a "finger slot". Second, Crawford neither mentions a "lid" nor that the finger slot is "provided" in that lid. Third, Crawford does not disclose that the lid covers an "image window of a scanner" of Crawford's machine.

Regarding independent claim 9, Crawford does not teach or suggest a system comprising "a finger slot that provides access to an image window in a scanner

portion of the multifunction peripheral”. Again, Crawford fails to disclose each of a “finger slot”, an “image window in a scanner portion”, and that the finger slot “provides access” to the image window.

Regarding independent claim 17, Crawford does not teach or suggest processor-readable instructions that cause one or more processors to obtain a biometric image “by scanning with a scanner portion of a multifunction peripheral a finger of a user contained within a finger slot defined within a lid that covers the scanner portion”. In regard to this claim, Crawford fails to disclose each of a “finger slot”, a “lid”, that the finger slot is “defined within” the lid, and that the lid “covers the scanner portion” of a device.

Regarding independent claim 25, Crawford does not teach or suggest a method comprising “scanning a potential user’s finger using the scanner that is used to scan documents”. Clearly, Crawford does not teach that a finger is scanned in Crawford’s system “using the scanner that is used to scan documents”. In view of Crawford’s disclosure, it is ludicrous to even suggest that the Crawford reference contains such a teaching. Once again, Crawford’s finger scanner is provided in the *user interface* of the Crawford’s machine. Clearly, Crawford’s user interface does not perform scanning of documents.

Regarding independent claim 27, Crawford does not teach or suggest a peripheral device comprising a data collection module that is configured to obtain a biometric image of a user finger “that is scanned by the scanner when the finger is placed on the image window” “upon which the documents are placed” for reasons discussed above in relation to claim 25.

2. Dependent Claims

Later in Office Action, the Examiner summarily dismisses explicit claim limitations of Applicant's dependent claims that, the Examiner admits, are not taught by Crawford. For example, the Examiner states:

Crawford does not provide details of the fingerprint sensor and does not appear to explicitly depict the sensor including a finger slot. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a finger slot adjacent to an image window in a scanner portion of the multifunction peripheral or a finger slot defined within the cover of a scanner portion of a multifunction peripheral. Applicant has not disclosed that providing a finger slot provides an advantage, is used for a particular purpose, or solves a stated problem.

[Office Action, page 4, section 6]

Regarding the second sentence, Applicant notes that the Examiner is stating a conclusion, not making an argument. In essence, the Examiner merely states that the "details" of Applicant's claims are obvious, period. This conclusory statement clearly does not rise to the level of a *prima facie* case for obviousness.

Regarding the third sentence, Applicant notes that the Applicant does not need to prove that the claimed invention has some particular "advantage" over the prior art, is used for some "particular purpose," or "solves a stated problem." The standards for patentability under 35 U.S.C. § 103(a), as described by the MPEP, are provided by the Examiner's reference above. Those standards say nothing of the things that are identified in the Examiner's third sentence above.

Even though statements of advantage, particular purpose, etc. are not required to "prove" patentability, Applicant notes that, contrary to that alleged by the Examiner, Applicant expressly provided such statements in Applicant's previous Response. In particular, Applicant stated:

Applicant notes that the above-identified distinction is significant. Specifically, the method described by Crawford requires that a separate sensor and its associated "circuitry" be integrated into the device user interface. Such a requirement can be disadvantageous for several reasons. First, the provision of such a sensor and its additional circuitry adds to the cost of the device. Second, the sensor requires user interface space that is typically scarce on such devices. In contrast to Crawford's teachings, however, Applicant utilizes an already-existing resource of a peripheral device to collect biometric data of a user, i.e. the device scanner. By doing so, no extra sensor or circuitry is necessary, therefore potentially lowering the cost of the device and freeing precious user interface space.

Given that Crawford only discloses embodiments that include a separate fingerprint sensor and associated circuitry, a person having ordinary skill in the art would not be motivated from the Crawford disclosure to practice "obtaining a biometric image of the user's finger by scanning the user's finger with the scanner" as is required by claim 1. Furthermore, given that Crawford says nothing about scanning the user's finger with the device scanner (as opposed to a separate sensor), such a person would certainly not be motivated to receive a user's finger within a finger slot "provided in a lid that covers an image window of a scanner of a multifunction peripheral".

[First Response, page 11, line 13 to page 12, line 6]

Later still in the Office Action, the Examiner states:

One of ordinary skill in the art, furthermore would have expected Applicant's invention to perform equally well with the fingerprint sensor disclosed by Crawford or the claimed finger slot because both provide a fingerprint reading in order to identify an authorized user of the multifunctional peripheral.

[Office Action, page 4, section 6]

In response, Applicant notes that what a person having ordinary skill in the art would have expected from Applicant's invention is *irrelevant* to the determination at issue. Again, the Examiner must establish that the prior art teaches or suggests each of Applicant's explicit claim limitations. If it does not, the claims are allowable over the prior art. Furthermore, it is improper to look to Applicant's own disclosure in formulating a conclusion of obviousness. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

3. Conclusion

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over the Crawford reference and that the rejection of these claims should be withdrawn.

B. Rejection of Claims 8, 16, and 29

Claims 8, 16, and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford as applied to claims 1, 9, and 27 in view of Edmonds, III, et al. ("Edmonds," U.S. Pat. No. 6,229,908). Applicant respectfully traverses this rejection.

As is identified above, Crawford fails to teach several explicit limitations of Applicant's independent claims. In that Edmonds does not remedy the deficiencies of the Crawford reference, Applicant respectfully submits that claims 8, 16, and 29, which depend from claims 1, 9, and 27, are allowable over the Crawford/Edmonds combination for at least the same reasons that claims 1, 9, and 27 are allowable over Crawford.

With particular reference to claim 8, Applicant notes that, contrary to that alleged in the Office Action, Edmonds does not teach a "resilient" shroud. Simply stated, there are no resilient members whatsoever provided in Edmonds' apparatus.

With specific reference to claims 16 and 29, Edmonds does not teach a "shroud". Instead, all Edmonds teaches is a fingerprint scanner 26, a light source 32, and a blood-alcohol detector 34. Crawford, column 3, line 65 to column 4, line 6; Figure 2.

C. Rejection of Claims 7, 15, 23, and 30

Claims 7, 15, 23, and 30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Crawford as applied to claims 1, 9, and 27 in view of Houdeau (U.S. Pat. No. 6,522,773). Applicant respectfully traverses this rejection

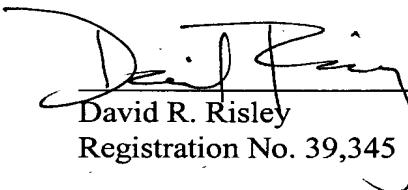
As is identified above, Crawford fails to teach several explicit limitations of Applicant's independent claims. In that Houdeau does not remedy the deficiencies of the Crawford reference, Applicant respectfully submits that claims 7, 15, 23, and 30,

which depend from claims 1, 9, and 27, are allowable over the Crawford/Houdeau combination for at least the same reasons that claims 1, 9, and 27 are allowable over Crawford.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

7/13/05

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Signature